



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,571	01/10/2002	Andrew Myers	23452-148	5212

29315 7590 02/23/2004

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC  
12010 SUNSET HILLS ROAD  
SUITE 900  
RESTON, VA 20190

EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/041,571

**Applicant(s)**

MYERS ET AL.

**Examiner**

Ovidio Escalante

**Art Unit**

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is in response to applicant's amendment filed on December 30, 2003. **Claims 1-23** are now pending in the present application.

#### *Claim Rejections - 35 USC § 103*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilcox et al. US Patent 6,404,856 in view of Becker et al. US Patent 2002/0130904.

*Regarding claims 1,12 and 18*, Wilcox teaches a system and a processor readable medium having process readable code embodied therein for annotating audible messages that are received by a subscriber of a unified communications service network, (abstract; col. 5, line 63-col. 6, line 6), the system comprising:

a message presentation form that enables the subscriber to access audible messages, (fig. 3; col. 4, lines 9-31; col. 6, lines 31-53), the message presentation form further comprising: an audible message player that enables playback of an audible message, (col. 1, line 62-col. 2, line 11; col. 4, lines 32-45); and

a notes field that enables the subscriber to annotate the audible message during playback of the audible message, (col. 4, lines 53-col. 5, line 17; fig. 3); and enabling the subscriber to annotate the audible message using the private notes field, (col. 4, line 53-col. 5, line 17).

Wilcox does not specifically teach a message forwarder that enables forwarding of audible messages and annotations at the option of the subscriber.

Becker teaches that it was well known in the art to have a message forwarder that enables forwarding of audible messages (paragraphs 47 and 89) to other recipients and wherein annotations are forwarded at the option of the subscriber, (paragraphs 51 and 56).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wilcox by allowing a user to forward annotated messages as suggested by Becker so that a user can forward messages to other users and so that information can be shared among said users.

***Regarding claims 2,8,13 and 19***, Wilcox teaches a search tool that enables search and retrieval of audible messages based, at least in part, upon annotations in the notes field, (col. 6, lines 31-63).

***Regarding claims 5,16 and 22***, Wilcox teaches wherein the message presentation form further comprises: a subject field that enables input of a subject heading for the audible message, (col. 4, line 62-col. 5, line 17; col. 6, line 31-63).

***Regarding claims 3,4,6,9,10,11,14,15,17,20,21 and 23***, While Wilcox teaches of annotating audible messages and a graphical user interface enables a user to input a subject heading into a subject field for the audible message, (col. 4, line 62-col. 5, line 17; col. 6, line 31-6), Wilcox does not specifically teach of forwarding annotations in the notes field or providing an option of forwarding the subject heading.

Becker teaches that it was well known in the art to have a message forwarder that enables forwarding of audible messages to other recipients and wherein annotations in the notes field are forwarded, (paragraphs 51 and 56) or wherein annotations in the notes field are not forwarded, (paragraphs 51 and 56). Becker further teaches wherein the message forwarder enables forwarding of audible message with the subject heading, (paragraphs 51,56 and 89).

Art Unit: 2645

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wilcox by allowing a user to forward annotated messages as suggested by Becker so that a user can forward messages to other users and so that information can be shared among said users.

*Regarding claim 7*, Wilcox teaches a system for annotating audible messages that are received by a subscriber of a unified communications service network, (abstract; col. 5, line 63-col. 6, line 6), the method comprising:

presenting the subscriber with a graphical user interface having a message presentation form that enables the subscriber to access audible messages, (fig. 3; col. 4, lines 9-31; col. 6, lines 31-53);

providing an audible message player associated with the graphical user interface that enables playback of an audible message, (col. 1, line 62-col. 2, line 11; col. 4, lines 32-45); and

providing a notes field associated with the graphical user interface that enables the subscriber to annotate the audible messages during playback of the audible message, (col. 4, lines 53-col. 5, line 17; fig. 3); and

Wilcox does not specifically teach a message forwarder that enables forwarding of audible messages and annotations at the option of the subscriber.

Becker teaches that it was well known in the art to have a message forwarder that enables forwarding of audible messages (paragraphs 36,47 and 89) to other recipients and wherein annotations are forwarded at the option of the subscriber, (paragraphs 51 and 56).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wilcox by allowing a user to forward annotated

Art Unit: 2645

messages as suggested by Becker so that a user can forward messages to other users and so that information can be shared among said users.

*Response to Arguments*

4. Applicant's arguments filed December 30, 2003 have been fully considered but they are not persuasive.

Applicants contend that Becker does not teach a message forwarder enabling forwarding of audible messages at the option of the subscriber, but instead teaches forwarding text messages.

While the Examiner acknowledges that Becker teaches forwarding text messages to another pal or to the user's archives with annotations as disclosed in paragraph 56, Becker provides for a plurality of different media situations.

In paragraph 36, Becker teaches that messages from multiple messaging-enabled devices may be received, Becker further teaches in paragraph 5 that messaging methods include **voice messaging**, electronic messaging, email fax, instant messaging, conferencing and chat. Therefore, Becker teaches that voice messages may be received and sent. This is further emphasized in paragraph 47 in which Becker discloses that many different types of messaging are possible including, audio messaging services. Each pal can use a plurality of different devices including telephones.

Therefore, while Becker provides specific examples for instant messaging and of forwarding text messages Becker provides a clear suggestion to use voice (audible) messaging.

In paragraphs 86-89, Becker uses a scenario, which involves audible messaging. Becker teaches that a user uses a microphone to leave a message for a pal. The user can then forward that message to other pals.

Therefore, since the user interface of Becker provides an interface for a plurality of different media formats then the Examiner believes that Becker discloses forwarding audible messages to another user and that the combination of Wilcox and Becker would have been obvious for one of ordinary skill in the art since forwarding of voice messages with annotations was well known in the art and so that additional information can be shared among users.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Art Unit: 2645

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9314, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington, VA, Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262.

The examiner can normally be reached on Monday to Friday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group  
is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35  
U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be  
addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO  
employees do not engage in Internet communications where there exists a possibility that  
sensitive information could be identified or exchanged unless the record includes a properly  
signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly  
set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and  
Trademark on February 25, 1997 at 1195 OG 89.



Art Unit: 2645

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ovidio Escalante  
Examiner  
Group 2645  
February 19, 2004

FAN TSANG  
SUPERVISOR/EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', written in a cursive style.